

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

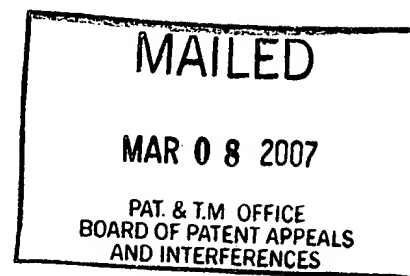
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER N. JAPP, DOUGLAS E. STERN,
RAYMOND J. KELLEY, JACK OBLEIN,
and DAVID M. ORESHACK

Appeal 2006-2114
Application 09/747,547
Technology Center 2100

Decided: March 8, 2007



Before KENNETH W. HAIRSTON, LANCE LEONARD BARRY, and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-45, the only claims pending in this application. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to system for geographically locating a particular medical resource. To this end, the client enters data into the system from a remote interface via a network. The system then searches for the desired medical resource and locates medical facilities providing the desired medical resource within a desired geographic region. *See generally* Specification 3:7-31. Claim 1 is illustrative:

1. A method for locating a medical resource, the method comprising:

electronically directing client data transmitted from a remote interface to a medical locator system via a network, wherein the medical locator system is configured for multiple modalities, the client data comprising a desired geographic region for locating a desired medical resource for at least one of the multiple modalities;

searching a database for the desired medical resource;

locating at least one of the desired medical resources based on the desired geographic region; and

electronically transmitting locator information to a client via the network, the locator information allowing the client to locate the desired medical resource.

The Examiner relies on the following prior art references to show unpatentability:

Dunworth	US 5,930,474	July 27, 1999
Killcommons	US 6,424,996 B1	July 23, 2002 (filed Nov. 25, 1998)

The rejection as presented by the Examiner is as follows:

Claims 1-45 are rejected under 35 U.S.C § 103(a) as unpatentable over Dunworth in view of Killcommons.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

OPINION

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner must establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). If that burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding independent claims 1, 16, 29, and 38, the Examiner's rejection essentially finds that Dunworth teaches a method for locating a medical resource with every claimed feature except for the medical locator

system to be configured for (1) multiple modalities (claim 1), (2) a desired medical resource (claims 16 and 29), and (3) locating at least one medical resource from a plurality of medical resources (claim 38). The Examiner cites Killcommons as teaching these features and finds that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the features in Dunworth's system to transfer complex data from a variety of modalities over email and web browser systems (Answer 3-5, 10-14).

Regarding independent claim 1, Appellants argue that the prior art does not disclose a medical locator system configured to employ location data to establish the position and availability of multiple modalities, much less a desired medical resource for one of the modalities. Appellants contend that Dunworth does not teach or suggest specific medical resources or different modalities, but merely shows an undifferentiated list of hospitals and health services that is typical of a listing in a yellow pages directory.

Regarding the secondary reference, Appellants acknowledge that Killcommons transfers medical information derived from different medical modalities, but emphasize that the reference pertains to transferring patient treatment and diagnostic data. According to Appellants, Killcommons does not differentiate medical resources by location or suggest the geographic locations of specific medical equipment. Appellants conclude that even if Killcommons' multiple modalities were combined with Dunworth, Dunworth would still be incapable of locating a desired medical resource associated with a particular one of the multiple modalities (Br. 9-10; Reply Br. 2-6).

We will sustain the Examiner's rejection of independent claim 1. Before turning to the prior art, we first interpret the term "modality" as claimed giving the term its broadest reasonable interpretation. "Modality" in the medical sense is defined as "treatment: something used in the treatment of a disorder, e.g. surgery or chemotherapy."¹

With this interpretation, we find that Dunworth's information retrieval system that enables the user to retrieve information geographically, topically, and via a yellow pages database amply would have suggested locating a desired medical resource for at least one of the multiple modalities as claimed given the scope and breadth of the limitation.

In Fig. 18, Dunworth shows an HTML page displaying retrieved information that lists hospitals and health services in Los Angeles (Dunworth, Fig. 18; col. 16, ll. 33-37). The listing includes the name, address, and phone number of the hospital or health service. Although Dunworth's listing is typical of an online yellow pages directory, the names of the facilities alone would have suggested vastly different medical resources² including differing treatment regimens and modalities used in treatment.

¹ See MSN Encarta, at <http://encarta.msn.com/encnet/features/dictionary/dictionaryhome.aspx>. See also Killcommons, col. 7, ll. 15-17 (noting that modalities "may be any type of device that generates data or data signals related to the examination of a subject").

² According to Appellants' specification, "medical resources may include a variety of medical equipment, systems, instruments and human resources for a particular medical procedure or medical practice. Furthermore, medical resources may include real estate, office space, healthcare service capacity, and financial resources of a particular institution" (Specification 5:17-21).

For example, three exemplary hospitals and health services listed in Fig. 18 are (1) “Womens Hospital” [sic], (2) “Children’s Hospital,” and (3) “Mental Health Services.” In our view, the skilled artisan would have readily recognized that medical treatment and the procedures employed in treatment at “Mental Health Services” (treatment for mental/psychological disorders) would be vastly different from treatment and associated procedures employed at “Womens Hospital” (treatment for female disorders). Moreover, the skilled artisan would have readily recognized that different modalities (i.e., things used in the treatment of a disorder) would be employed in the respective procedures performed at these different facilities.

In addition to providing the listings noted above from the yellow pages database, Dunworth teaches providing “other miscellaneous information” pertaining to the selected topic or subtopic from the “YP Notes” portion of the yellow pages database (Dunworth, col. 10, ll. 16-30; Fig. 2C). Although Dunworth is silent regarding specifically what constitutes “other miscellaneous information,” hospitals and health care facilities often include information regarding their equipment and facilities in online yellow pages listings.³ This information is not only useful to the consumer when deciding upon a particular health care facility, but also functions as an advertising tool for hospitals and health care facilities in touting their treatment capabilities and equipment to the general public. For at least this reason, we see no reason why the skilled artisan would have not

³ See, e.g., Superpages.com listing for Lenox Hill Hospital, New York, NY, at <http://www.superpages.com> (advertising ultrasound capability). See also *id.*, Deborah Heart & Lung Center, Brown Mills, NJ (balloon angioplasties and cardiac catheterization); Inova Urgent Care Center, Vienna, VA (touting x-ray services).

have included modality information along with the individual hospital/health services listings in Dunworth.

Thus, we sustain the Examiner's obviousness rejection based on the teachings of Dunworth alone because the Board may rely on fewer references than the Examiner in affirming a multiple-reference rejection under 35 U.S.C. § 103. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2, 150 USPQ 441, 444 n.2 (CCPA 1966).

That said, we also find that the teachings of Killcommons are reasonably combinable with Dunworth. Although Killcommons pertains to transferring data from multiple modalities for patient diagnostics and treatment as Appellants indicate, the reference nonetheless provides detailed information regarding medical modalities and their use in various medical treatments. *See* Killcommons, col. 1, ll. 48-65 (including data image acquisition equipment used for, among other things, heart scanning). *See also id.*, col. 7, ll. 23-43 (discussing exemplary medical modalities). We find the skilled artisan would have reasonably referred to the teachings of Killcommons to at least determine the nature of modalities and their use in medical treatment.

Because the collective teachings of Dunworth and Killcommons would have suggested to the skilled artisan all limitations of claim 1, the Examiner's obviousness rejection of that claim is sustained. Since Appellants have not separately argued the patentability of dependent claims 2-5 and 7-15, these claims fall with independent claim 1. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding independent claims 16, 29, and 38, we disagree with Appellants contention that Dunworth's online yellow pages provides very general information and is therefore incapable of locating a desired medical resource as claimed (Br. 10-11; Reply Br. 6). In our view, Dunworth's system that lists hospitals and health services in a desired geographic region in Fig. 18 fully meets "a resource locator system configured for locating a desired medical resource" as claimed.

Significantly, the specific listings in Fig. 18 constitute "desired medical resources" even with Appellants' own definition. According to Appellants' specification, "medical resources may include a variety of...*human resources* for a particular medical procedure or medical practice. Furthermore, medical resources may include *real estate*, *office space*, healthcare service capacity, and financial resources of a particular institution" (Specification 5:17-21; emphasis added). Certainly, the skilled artisan would recognize that the individual hospitals and health services retrieved and displayed in Fig. 18 would have professional staff (i.e., human resources), real estate, and office space associated with the facilities' respective medical practices. Even absent accompanying "miscellaneous other information,"⁴ the listings in Fig. 18 reasonably constitute "desired medical resources" giving the term its broadest reasonable interpretation.

Regarding independent claim 38, retrieving the hospital and health services in Los Angeles listed in Fig. 18 in Dunworth requires searching a (1) geography database; (2) local content database; and (3) a yellow pages database (Dunworth, abstract; Figs. 2A-2C). In our view, Dunworth's database-driven search system that retrieves "desired medical resources"

⁴ See P. 6, *supra*, of this opinion.

fully meets “searching a medical locator database for the at least one medical resource” as claimed.

For at least the above reasons, we will sustain the Examiner’s rejection of independent claims 16, 29, and 38. Although we find that Dunworth actually anticipates these claims, obviousness rejections can nonetheless be based on references that happen to anticipate the claimed subject matter. *In re Meyer*, 599 F.2d 1026, 1031, 202 USPQ 175, 179 (CCPA 1979). Also, we may rely on fewer references than the Examiner in affirming a multiple-reference rejection under 35 U.S.C. § 103. *Bush*, 296 F.2d at 496, 131 USPQ at 266-67; *Boyer*, 363 F.2d at 458 n.2, 150 USPQ at 444 n.2.

Since Appellants have not separately argued the patentability of dependent claims 17-20, 23-26, 28, 31-37, and 40-45, these claims fall with independent claims 16, 29, and 38. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding claims 6 and 22, Appellant argues that the prior art does not disclose a selection from a plurality of medical imaging systems or receiving such a selection (Br. 12-13; Reply Br. 7). The Examiner argues that Killcommons teaches selecting from different types of medical imaging systems (i.e., medical information), and Dunworth teaches requesting information by topic – topics that can include medical information (Answer 20).

We will sustain the Examiner’s rejection of claims 6 and 22. At the outset, we note that these claims essentially recite the content of the client data. But since data content does not further limit the claimed invention

either functionally or structurally, it essentially constitutes non-functional descriptive material. Such non-functional descriptive material does not patentably distinguish over prior art that otherwise renders the claims unpatentable. *See In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).

Although we sustain the Examiner's rejection on this ground alone, we nevertheless agree with the Examiner that the collective teachings of Dunworth and Killcommons would have reasonably suggested to the skilled artisan that multiple medical resources would have included medical imaging systems. As we indicated previously, we see no reason why the skilled artisan would not have included modality information along with the individual hospital/health services listings in Dunworth for advertising their treatment capabilities and equipment to the general public.⁵ Moreover, Killcommons explains that modalities include a variety of different medical imaging systems (Killcommons, col. 7, ll. 23-43). Given these collective teachings, we find that the skilled artisan would have reasonably included medical imaging systems as part of the displayed modality information in conjunction with the hospital/health services listings in Dunworth. The Examiner's rejection of claims 6 and 22 is therefore sustained.

Regarding claims 21, 30, and 39, Appellant argues that the prior art does not disclose making a selection of any type of particular medical resource, much less making a selection from multiple modalities as claimed. Appellants also argue that the prior art does not disclose a query form or field for making or entering such a selection (Br. 13; Reply Br. 7).

⁵ See P. 5-6, *supra*, of this opinion.

We will sustain the Examiner's rejection of claims 21, 30, and 39. Our previous discussion regarding including modality information along with medical information applies equally here and we incorporate that discussion by reference.⁶ Regarding claim 30, we add that Dunworth's browser display enables the user to select a desired topic from multiple topics including "Emergency Services" and "Hospitals and Clinics" (Dunworth, Fig. 10). In our view, such a selection capability reasonably meets a "query form" comprising a field that ultimately enables the user to select the desired medical resource from a plurality of medical resources as claimed.

Regarding claim 27, Appellant argues that the prior art does not disclose a map system, much less a map system remote from a locator system as claimed. Appellant contends that Dunworth's image map merely initiates a geographical search of a consumer product or service, but does not pinpoint or map a location of a specific medical resource (Br. 13). The Examiner argues that Dunworth displays reference maps to the user so that the user can select particular geographical areas. According to the Examiner, such a teaching would enable more efficient searching/requesting of medical information (Answer 22).

We will sustain the Examiner's rejection of claim 27. In short, Appellant's arguments are simply not commensurate with the scope of the claim. Dunworth's image map enables the user to select a desired geographical region from an actual map to refine the search query and ultimately the search results (Dunworth, col. 13, l. 7 – col. 14, l. 13). This displayed map certainly "maps out" a geographic location of the desired

⁶ See P. 5-7, *supra*, of this opinion.

medical resource as claimed. Also, Dunworth's map system is, at least in part, remote from the resource locator system in that the image map is rendered at the user's browser – a user interface remote from the server. *See* Dunworth, Figs. 4 and 8. Moreover, implementing image maps at the client browser (i.e., remote from the server) is well known in the art.⁷ In short, Dunworth's image map fully meets the claimed limitations given their broadest reasonable interpretation. The Examiner's rejection of claim 27 is therefore sustained.

DECISION

We have sustained the Examiner's rejection with respect to all claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-45 is affirmed.

⁷ *See, e.g.,* Dave Raggett, et al., *HTML 4.01 Specification, W3C Recommendation, 13.6: Image Maps*, Dec. 24, 1999, at <http://www.w3.org/TR/1999/REC-html401-19991224/struct/objects.html#h-13.6> (discussing client-side and server-side image maps).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2004).

AFFIRMED

PGC

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